

CENT

DEC 02 2004

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicant: M. Masters et al.

Certificate of Transmission
Pursuant to 37 C.F.R. § 1.8

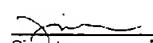
Serial No.: 09/944,314

For: Processes for texturing the surface
of a hearing instrumentI hereby certify that this paper is being sent this
day via facsimile to 703-872-9306.

Filed: August 31, 2001

Joel Miller
Attorney Name29,955
Reg. No.

Group: 1734

December 9, 2004
Date of Signature

Examiner: Jerry A. Lorengo

Signature

Att'y Dkt.: 2001 P 16282 US

Reply Brief on AppealCommissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Via Facsimile Only

Sir:

This reply responds to the examiner's answer mailed October 13, 2004.

Argument

The legal standard applied in the office actions and the answer is incorrect. During prosecution of a patent application, claims are not to be given their broadest interpretation. Rather, they are to be given their "broadest reasonable interpretation consistent with the specification." *In re Hyatt*, 211 F.3d 1367, 1372, 54 U.S.P.Q.2d 1664, 1667 (Fed. Cir. 2000); M.P.E.P. § 2111 (8th ed., rev. 2, May 2004), page 2100-46 (first sentence). Therefore, while the claims are to be broadly interpreted, this interpretation is not without limit; it must be both "reasonable" and "consistent with the specification."

Indeed, to reach a construction "consistent with the specification," the specification must be considered -- not for the purpose of reading limitations into the claims but rather to understand the usage of the claim's terms and the devices to which they apply. And, "this interpretation must be consistent with the one that those skilled in the art would reach." *In re Cortright*, 165 F.3d 1353, 1358, 49 U.S.P.Q.2d 1464, 1467 (Fed. Cir. 1999); M.P.E.P. § 2111 (8th ed., rev. 2, May 2004), page 2100-47 (last paragraph in the left-hand column). Without such a restriction, claims would read upon structures and processes far beyond those contemplated by persons skilled in the art.

Two Federal Circuit opinions, cited in the answer to bolster the rejections based upon the Walter and Bowser et al. references, emphasize the need to consider how the terms of a claim are used by those skilled in the art. Answer, p. 6, n. 5. In the first, the court noted that "[t]here is a heavy presumption that the terms used in claims 'mean what they say and have the ordinary meaning that would be attributed to those words by persons skilled in the relevant art.'" *SuperGuide Corporation v. DirecTV Enterprises, Inc.*, 358 F.3d 870, 874,

SH40043

S.N. 09/944,314 // Docket No. 2001 P 16282

69 U.S.P.Q.2d 1865, 1868 (Fed. Cir. 2004), quoting Texas Digital Systems, Inc. v. Telegenix, Inc., 308 F.3d 1193, 1202, 64 U.S.P.Q.2d 1812, 1817 (Fed. Cir. 2002).

Similarly, in the second opinion, the court wrote “[g]enerally speaking, we indulge a ‘heavy presumption’ that a claim term carries its ordinary and customary meaning.” E-Pass Technologies, Inc. v. 3Com Corporation, 343 F.3d 1364, 1368, 67 U.S.P.Q.2d 1947, 1950 (Fed. Cir. 2003). “Ordinary and customary meaning” is that employed by those skilled in the art. M.P.E.P. § 2111.01(I) (8th ed., rev. 2, May 2004), page 2100-46 (“Plain Meaning’ Refers to the Ordinary and Customary Meaning Given to the Term by Those of Ordinary Skill in the Art” and subsequent text); Brookhill-Wilk 1, L.L.C. v. Intuitive Surgical, Inc., 334 F.3d 1294, 1298, 67 U.S.P.Q.2d 1132, 1136 (Fed. Cir. 2003) (“[t]he words used in the claims are examined through the viewing glass of a person skilled in the art”). Therefore, claim construction must take into account how a person skilled in the art would understand the claim terminology.

The answer sidesteps these requirements and the result is an interpretation neither “reasonable” nor “consistent with the [applicants’] specification” and contrary to one a person skilled art would reach.

“Hearing Instrument” is a term of art

The invention described and claimed in the application is a method for imparting a texture to a “hearing instrument.” Read fairly, the claims delineate “hearing devices inserted in a user’s ear,” specification, page 1, line 4; those skilled in the art of hearing instruments would not place a telephone handset (Walter) or a pair of headphones (Bowser et al.) in this category. Even during the patent prosecution phase, there is a limit to the breadth accorded claim language; otherwise, the claims in this application could theoretically read on anything remotely related to hearing.

The term “Texture” has limited meaning in the context of the application

“Reasonably” construed, the step of “imparting a texture” to a hearing instrument surface or shell means a modification of the surface or the shell itself - not applying a layer on top of the shell or surface. Those skilled in the art would not equate affixing a mesh screen to the outer ear (Hoerkins) or encapsulating a housing in a sponge-like material or fabricating the housing from the same (Yoest et al.) with “imparting a texture.” Nor would they consider the placement of reinforcing ribs on the exterior of a smooth enclosure (Widmer et al.) or providing a textureless smooth, glossy finish (applicants’ specification - background of the invention, p. 1, lines 4-10) to fall within such a description. Again, there is a reasonable limit to the breadth of the meaning of the term “texture” as used in the specification and the claims.

The appeal brief’s summary of the invention is characterized as “inaccurate” (Answer, page 2, section 5), apparently, because it does not agree with the construction of the claims urged in the answer. The applicants, experienced in the art of hearing instrument design and manufacturing, submit that the summary is indeed an accurate description of their invention.

Reply to Specific Arguments in the Answer

The argument section (11) of the answer raised several issues dealt with below in similarly-enumerated paragraphs.

I. Claim 2 does not describe a smooth surface

On page 5 of the answer, it is argued that claim 2 must necessarily contemplate a "smooth" surface because it lacks the phrase "non-smooth" of dependent claim 3. Nothing in the application or the prosecution history supports this conclusion. And claim differentiation does not require such a result. Claim 2 recites a texture that may be defined in numerous other ways, as illustrated by dependent claims 5, 6, and 7.

VI. One skilled in the art would not select Widmer et al. for a texture

The answer relies upon *In re Heck*, 699 F.2d 1331, 216 U.S.P.Q. 1038 (Fed. Cir. 1983) (page 9, note 7, and earlier in note 6 with regard to Hoerkens) for the proposition that patent references are "relevant for all they contain." Such relevance does not occur in a vacuum, however. The section of the M.P.E.P. quoting this opinion goes on to state that "[a] reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art...." M.P.E.P., § 2123 (8th ed., rev. 2, May 2004), page 2100-64. Thus, the teaching must be recognized by one skilled in the art as relevant. The applicants submit that Widmer et al. is not relevant to the claimed invention.

The application provides that "the textured finish has an appearance closer to that of natural skin and therefore the hearing instrument is less noticeable to others, blending in with the visible portions of the ear." Application, page 2, lines 10-13. Absent some gross deformity or disease, skin does not have the appearance of the structural reinforcing ribs (on an otherwise smooth surface) shown in Widmer et al.:

U.S. Patent Jun. 11, 2002 Sheet 10 of 15 US 6,401,859 B1

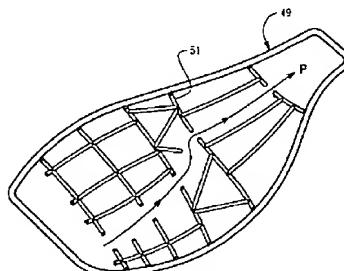


Fig. 18

Additionally, such large and sharp-edged protrusions on the exterior of the hearing instrument shell would lead to discomfort (perhaps even laceration of the ear canal). Cf. applicants' abstract, page 14, lines 1-3 ("[t]he physical fit, comfort, and appearance of a hearing instrument that resides in the ear can be improved by providing the shell of the instrument with a textured finish"). Use of the rib structure of Widmer et al. would clearly be contrary to the

goals of the skilled artisan, since the interpretation of the claims "must be consistent with ... one that those skilled in the art would reach." *In re Cortright*, 165 F.3d at 1358, 49 U.S.P.Q.2d at 1467. Manufacturers of hearing instruments are quite concerned with the appearance of their products and strive to make them inconspicuous. The rib pattern depicted in Widmer et al. would only draw attention to the instrument and possibly hurt the user. Thus, the assertion that "texture" reads on the rib structure of Widmer et al. is not a "reasonable" conclusion.

The Arguments do not overcome the Failure to Meet the Claim Limitations

All of the foregoing concern rejections under § 102. The arguments presented in the answer do not cure the failure to teach all of the claimed elements and therefore these rejections remain untenable. For at least the same reason and for lack of a motivation to modify the cited references, none of these would support a rejection under § 103.

VII. The art lacks the necessary motivation to combine (§ 103 rejection)

On page 9 and 10, the answer asserts that the motivating factor for combining the references is "that the provision of waveforms to the surface of the hearing aid shell can enhance comfort and security of the hearing aid when worn" was a known concept. Answer, page 10. The applicants are unable to find support for such a statement in either reference and suggest that it is merely a product of hindsight generated by reference to their claims.

Moreover, the answer concedes that "the motivation to combine the Widmer et al. and Hoerkens reference[s] is based only upon knowledge which was within the level of ordinary skill in the art at the time the claimed invention[] [was] made...." Answer, page 10. However, "[t]he level of skill in the art cannot be relied upon to provide the suggestion to combine references." M.P.E.P. § 2143.01 (8th ed., rev. 2, May 2004), p. 2100-129, citing *Al-Site Corporation v. VSI International, Inc.*, 174 F.3d 1308, 1324, 50 U.S.P.Q.2d 1161, 1171 (Fed. Cir. 1999) ("[s]kill in the art does not act as a bridge over gaps in substantive presentation of an obviousness case..."). Therefore, the combination of Widmer et al. and Hoerkens is improper and the rejection is similarly without basis.

Conclusion

When the totality of the application and the prosecution history is considered, a reasonable construction of the claim terminology, including "hearing instrument" and "texture," consistent with the specification and one that a person skilled in the art would reach, cannot encompass the cited art. The applicants respectfully request that the Board reverse the examiner and direct that the application be passed to allowance.

Dated: December 9, 2004

Respectfully submitted,


Joel Miller
Reg. No. 29,955
17 Westwood Drive South
West Orange, N.J. 07052
(973) 736-8306
Attorney for Applicant(s)